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EXAMINER

COBURN, CORBETT B

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 01/30/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,061

Applicant(s)

COLE ET AL.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Examiner rejects Applicant's suggestion for an amended title. The primary thrust of Applicant's claims appears to be to filling out tax-related forms and the title should make some mention of this fact.

Claim Objections

2. Claims 16 & 17 are objected to because of the following informalities: Claims 16 & 17 are purported to be currently amended. No amendments are indicated. Examiner assumes that no amendments have been made. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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4. Claims 11-19, 22-25, 27-33, 35-44 & 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Acres (US Patent Number 6,312,333).

Claims 11, 12, 14, 16, 17, 24, 25, 28, 29, 36, 37, 39, 41, 42: Claims 11, 12, 14, 16, 17 are clearly anticipated by Acres – See Figs 1-3 & Summary of the Invention.

Claims 13, 38: Acres teaches that the database contains all the information necessary to complete the W2-G. (Col 5, 28-31) This inherently includes the player's name, address & tax identification number.

Claims 15, 40: Fig 2 shows a gaming machine (12) with a microprocessor (52) that is programmed with the protocol necessary to carry out uninterrupted play – i.e., play without intervention of casino personnel.

Claims 18, 43: Acres discloses a number of keys or buttons such as the spin button (53) and coin-in button (Col 4, 46), etc. This is essentially a keypad.

Claims 22, 27, 35, 47: Acres discloses that the gaming machine is in a casino. Thus physical access to the gaming machine is limited to casino patrons. Casino patrons are given physical access to the gaming machines.

Claim 23: Acres teaches a computer network that must inherently include a computer program product. This program enables the network to allow for an uninterrupted play session on a gaming machine even when a reportable jackpot is won – i.e., no intervention by casino personnel is required. There is code to enable a central storage computer to store player related information (88) There is code to allow a gaming machine to enter uninterrupted play in response to user input – insertion of card (66) into card reader (60). There is code to enable the gaming machine to send signals

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representing jackpot-related information to the central storage computer (44), which is receive and recorded whenever a reportable jackpot is won. There is code to enable the gaming machine to communicate to the central computer that an uninterrupted session has ended (i.e., the cash out signal). There is code to allow the central computer to generate a statement including player-related information and jackpot-related information (i.e., W2-G) after an uninterrupted session has ended. (Col 7, 33-43)

Claim 30: Acres teaches gathering information necessary to complete IRS Form W2-G. IRS regulations require the casino to fill out Form W2-G for certain jackpots. The instructions for the form require identification numbers from a driver's license, social security card, or voter registration to be inserted into boxes 11 & 12 of the Form W2-G. Thus looking at these documents is inherently required by Acres' disclosure.

Claim 31: Acres teaches filing the W2-G. (Col 6, 26-28)

Claim 32: The W2-G is a statement of the jackpot-related information. It is provided to the player.

Claims 19, 33: Since the game machines can play an uninterrupted game, they must be enabled to execute a protocol putting the gaming machine in uninterrupted mode.

Claim 44: The protocol for uninterrupted play is inherently capable of being activated by an enabling event. Some event must enable the described process to take place. This event is, by definition, an enabling event.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1, 2 & 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bell et al. (US Patent Number 5,505,461) in view of Acres (US Patent Number 6,312,333).

Claim 1: Bell teaches a method of allowing a player to participate in an uninterrupted gaming session when a jackpot over a threshold amount is won. (Col 3, 58-60) Bell teaches collecting and storing player-related information. (Col 5, 39-42) Bell teaches recording the jackpot-related information whenever a jackpot greater than a threshold amount is won and crediting winnings to the player. (Col 3, 30-42) Bell also teaches generating a statement referencing the recorded jackpot information and player information after the player is done playing. (Col 4, 43-60) Bell teaches use of player tracking cards, but fails to teach the details of the system. Player tracking systems are extremely well known to the art. They allow casinos to keep track of player activities so that the casinos can tailor their marketing to patron requirements. Acres teaches a tracking device having a central server that is connected to the gaming machine. (Fig 2, 60) & Col 2, 1-10) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell to include a tracking device having a central server that is connected to the gaming machine as taught by Acres in order to carry out Bell's teaching of using a player tracking system and to allow casinos to keep track of player activities so that the casinos can tailor their marketing to patron requirements.

Claim 2: Bell's preprogrammed gaming machine is allowed to play an uninterrupted game even if a reportable jackpot is won. (Col 3, 58-60)

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Claim 4: Bell's player is given physical access to the game of chance dedicated to uninterrupted play. (Fig 1) The player actually gets to touch the slot machine to pull handle (14).

Claim 5: Bell teaches verifying a player's identity and citizenship. (Col 5, 19-25)

While the method of doing so is not stated, this could not be done without viewing documents that qualify as proof of the player's identity.

Claim 6: Bell teaches gathering tax-related information from the player. (Col 5, 19-25)

Claim 7: Bell teaches verifying the player's identity but does not explain in detail how to accomplish. (Col 5, 19-25) IRS regulations require the casino to fill out Form W2-G for certain jackpots. The instructions for the form require identification numbers from a driver's license, social security card, or voter registration to be inserted into boxes 11 & 12 of the Form W2-G. Thus looking at these documents is required by Bell's disclosure.

Claim 8: Bell teaches that the tax-related information is the player's name and tax identification number (Col 5, 19-25), but does not specifically disclose collecting the address. Bell teaches filling out Form W2-G, which requires the player's address. Thus the collection of the address data is inherent in Bell's disclosure.

Claim 9: IRS regulations require that the Form W2-G be filed (i.e., reported to a taxing authority) when the jackpot exceeds a certain threshold. While Bell does not specifically disclose filing the paperwork, there would be no other reason to generate the form. Thus Bell teaches reporting the jackpot to the IRS by implication or, in the alternative, it would have been obvious to one of ordinary skill in the art at the time of the invention to have filed the Form W2-G in order to comply with IRS regulations.

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Claim 10: Bell teaches providing the player with a statement referencing jackpot information after the player is done playing. (Col 4, 53-60) The W2-G is such a statement.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bell and Acres as applied to claim 1 in view of Bergeron et al. (US Patent Number 4,882,473) and Pease et al. (US Patent Number 5,326,104).

Claim 3: Bell and Acres teach the invention substantially as claimed including the use of a player card. Bell and Acres do not teach inserting an agent card or selecting uninterrupted play from a menu. Bergeron teaches insertion of an agent card for the purpose of enhancing security. (Abstract) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Belle and Acres to require the insertion of an agent card to enhance security as taught by Bergeron. Menus are ubiquitous – virtually every computer system that allows a selection provides a menu. Pease teaches a menu-driven system and states that menu-driven systems are easy to operate. (Col 17, 67-68) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Bell and Acres to allow the selection of uninterrupted play from a menu screen on the display as taught by Pease in order to make the system easy to operate.

8. Claims 20, 21, 26, 34, 45 & 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acres as applied to claim 19, 24, 33, or 44 (if applicable) in view of Bergeron et al. (US Patent Number 4,882,473) and Pease et al. (US Patent Number 5,326,104).

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Claims 20, 26, 34, 45: Acres teaches the invention substantially as claimed including the use of a player card and the details of network communication and signaling. Acres does not teach inserting an agent card or selecting uninterrupted play from a menu. Bergeron teaches insertion of an agent card for the purpose of enhancing security. (Abstract) Bergeron also teaches entering enabling information (a PIN) into a keypad (72) in communication with the gaming machine. (Col 7, 53-61) This also enhances security. It would have been obvious to one of ordinary skill in the art at the time of the invention to have required the insertion of an agent card and the use of a PIN prior to allowing user access in order to enhance security. While Bergeron appears to allow the agent card (10) to remain in the card reader when the player card is in use, Bergeron has two card readers. Acres teaches a device with one card reader. A machine with one card reader is cheaper than the same machine with two. It would have been obvious to one of ordinary skill in the art at the time of the invention to have removed the agent card from the card reader prior to inserting the user card so that the same card reader could be used for both cards, thus reducing costs.

Menus are ubiquitous – virtually every computer system that allows a selection provides a menu. Pease teaches a menu-driven system and states that menu-driven systems are easy to operate. (Col 17, 67-68) It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected uninterrupted play from a menu screen on the display in order to make the system easy to operate.

Claim 21, 46: Acres teaches using data on a player-tracking card to identify the player using a particular machine. Since the card identifies the player that is playing the

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machine, removing the card would make it impossible to look up the player record as required in step 88 of Fig 3. Therefore, Acres effectively teaches deactivating uninterrupted play when the player removes the card from the card reader.

Response to Arguments

9. Applicant's arguments filed 17 November 2003 have been fully considered but they are not persuasive.

10. Applicant's arguments with respect to Bell are drawn to the claims as amended and are answered above.

11. Applicant argues that Acres teaches locking up the machine when a payout over a threshold is awarded. While this is true, Acres teaches that in cases where the player already has the necessary information on file, the system will, "Immediately approve the award and make payment." (Col 6, 50-55) Thus no delay is encountered.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	US Patent Number	Applicability
LeStrange et al.	5,470,079	Cashless gaming
Craine	5,321,241	Cashless gaming
Dickinson et al.	5,265,874	Cashless gaming

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Cbc


JESSICA HARRISON
PRIMARY EXAMINER